

### REMARKS

Forty-two claims were originally filed in the present Application. Claims 1-42 currently stand rejected. Claims 1, 4, 8, 11, 21, 24, 28, and 31 are amended herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

### Effective Filing Dates

On page 2 of the Office Action, the Examiner states that claims 1, 2, 21, 22, and 42 are “supported . . . by the provisional application . . . .” Applicants concur. The Examiner also states that “select portions of claims 3 and 23 . . . have been found to be supported . . . by the provisional application . . . .” The Examiner then states that “[a]ll remaining independent claims and dependent claims have received the effective filing date of February 8, 2001, which is the current effective filing date of the non-provisional application.”

Applicants respectfully traverse. Each dependent claim incorporates by reference a respective independent claim, which by the Examiner’s own admission, is supported by the provisional application. Therefore, at the very least, all dependent claims are partially supported by the provisional application. The same argument applies to independent claim 41, which contains language similar to independent claim 21.

In addition, Applicants submit that many of the claims indicated by the Examiner as being unsupported by the provisional application contain limitations that are disclosed or suggested in the provisional application. For example,

Applicants submit that claims 4, 8, 12, 24, 28, and 32 are supported by the provisional application in their entirety. Furthermore, Applicants submit that claims 3, 5, 10, 11, 23, 25, 30, 31, and 35 contain limitations that are disclosed in the provisional patent application, without regard to any incorporated limitations from the respective independent claims.

For at least the foregoing reasons, Applicants submit that that the effective filing date for more of the current claims should be the filing date of the provisional application, March 6, 2000. Applicants therefore request the Examiner to reconsider the effective filing dates in light of the teachings of the provisional application, and then to explicitly respond to the foregoing arguments in the next Office Action. Applicants also hereby expressly reserve the future right of continuing to contest or traverse the effective filing dates of any of the claims of the present application.

35 U.S.C. § 102(e)

On page 3 of the Office Action, the Examiner rejects claims 1-4, 19-24, 39-40, and 42 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,304,284 to Dunton et al. (hereafter Dunton). The Applicants respectfully traverse these rejections for at least the following reasons.

“For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that Dunton fails to identically teach every element of the

claims, and therefore does not anticipate the present invention.

Regarding the Examiner's rejection of independent claims 1 and 21, Applicants respond to the Examiner's §102 rejection as if applied to amended independent claims 1 and 21 which now recite a scanning manager "extracting still frames from said contiguous frame sequence in a non-sequential manner to represent said target object as said still image," which are limitations that are not taught or suggested either by the cited references, or by the Examiner's citations thereto.

Dunton teaches a "camera system for generating panoramic images" in which a "processor reconstructs a single panoramic image from the recorded images using the recorded orientation information" (see Abstract). However, Applicants submit that Dunton nowhere teaches or suggests "extracting still frames" from video data in a non-sequential manner, as claimed by Applicants. Applicants therefore submit that the rejections of amended claims 1 and 21 are improper.

With regard to claim 42, "means-plus-function" language is utilized to recite elements and functionality similar to those recited in claims 1 and 21 which are further discussed below. Applicants therefore incorporate those remarks by reference with regard to claim 42. In addition, the Courts have frequently held that "means-plus-function" language, such as that of claim 42, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof. Applicants

respectfully submit that, in light of the substantial differences between the teachings of Dunton and Applicants' invention as disclosed in the Specification, claim 42 is therefore not anticipated or made obvious by the teachings of Dunton.

Regarding the Examiner's rejection of dependent claims 2-4, 19-20, 22-24, and 39-40, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 2-4, 19-20, 22-24, and 39-40, so that these claims may issue in a timely manner.

Because a rejection under 35 U.S.C. §102 requires that each claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Dunlop to identically teach or suggest the claimed invention, Applicants respectfully request reconsideration and allowance of claims 1-4, 19-24, 39-40, and 42, so that these claims may issue in a timely manner.

### 35 U.S.C. § 103

On page 3 of the Office Action, the Examiner rejects claims 5-11, 14, 25-31, and 34 under 35 U.S.C. § 103 as being unpatentable over Dunton in view of U.S. Patent No. 5,497,188 to Kaye (hereafter Kaye). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicants respectfully traverse the Examiner's assertion that modification of the device of Dunton according to the teachings of Kaye would produce the claimed invention. Applicants submit that Dunton in combination with Kaye fail to teach a substantial number of the claimed elements of the present invention. Furthermore, Applicants also submit that neither Dunton nor Kaye contain teachings for combining the cited references to produce the Applicants' claimed invention. The Applicants therefore respectfully submit that the obviousness rejections under 35 U.S.C §103 are improper.

Regarding the Examiner's rejection of dependent claims 5-11, 14, 25-31, and 34, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when

viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 5-11, 14, 25-31, and 34, so that these claims may issue in a timely manner.

In addition, Applicants submit that the cited references fail to teach generating an “error warning” in response to an “invalid scan parameter” that includes a “negative overlap setting”, as claimed by Applicants in claims 7 and 27. Furthermore, Applicants also submit that the cited references fail to teach a “keyframe format”, as claimed by Applicants in claims 10 and 30.

For at least the foregoing reasons, the Applicants submit that claims 5-11, 14, 25-31, and 34 are not unpatentable under 35 U.S.C. § 103 over Dunton in view of Kaye, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 5-11, 14, 25-31, and 34 under 35 U.S.C. § 103.

On page 8 of the Office Action, the Examiner rejects claims 12 and 32 under 35 U.S.C. § 103 as being unpatentable over Dunton and Kaye in view of U.S. Patent No. 4,793,812 to Sussman et al. (hereafter Sussman). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim

limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 12 and 32, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 12 and 32, so that these claims may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claims 12 and 32 are not unpatentable under 35 U.S.C. § 103 over Dunton and Kaye in view of Sussman, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 12 and 32 under 35 U.S.C. § 103.

On page 10 of the Office Action, the Examiner rejects claims 13, 15-18, 33, and 35-38 under 35 U.S.C. § 103 as being unpatentable over Dunton and Kaye in view of U.S. Patent No. 6,002,124 to Bohn et al. (hereafter Bohn). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior

art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 13, 15-18, 33, and 35-38, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 13, 15-18, 33, and 35-38, so that these claims may issue in a timely manner.

In particular, as discussed above, Applicants submit that the cited references fail to teach generating an "error warning" in response to an "invalid scan parameter" that includes a "negative overlap setting", as claimed by Applicants in claims 7 and 27. Furthermore, Applicants submit that the cited references fail to teach a system that "combines said video data in said overlap region", as claimed by Applicants in claims 18 and 38.

For at least the foregoing reasons, the Applicants submit that claims 13, 15-18, 33, and 35-38 are not unpatentable under 35 U.S.C. § 103 over Dunton and Kaye in view of Bohn, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 13, 15-18, 33, and 35-38 under 35 U.S.C. § 103.



On page 12 of the Office Action, the Examiner rejects claim 41 under 35 U.S.C. § 103 as being unpatentable over Dunton and Kaye in view of the Examiner's Official Notice. The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

In the rejections of claim 41, the Examiner concedes that "neither Dunton nor Kaye teach the above steps taking the form of program instructions within a computer-readable medium." Applicants concur. The Examiner then takes Official Notice to support the rejection of claim 41, without citing any specific references against the admitted deficiencies in Dunton and Kaye. Applicants therefore respectfully request the Examiner to cite specific references in support of the Official Notice, and failing to do so, to reconsider and withdraw the rejections of claim 41, so that this claim may issue in a timely manner.

Furthermore, the Court of Appeals for the Federal Circuit has held that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination." In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d

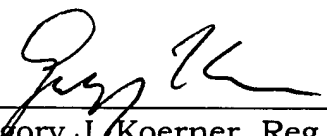
1276, 1278 (Fed. Cir. 1987). Applicants submit that the cited references, in combination with the Official Notice, do not suggest a combination that would result in Applicants' invention, and therefore the obviousness rejection under 35 U.S.C §103 is improper. Applicants therefore respectfully request the Examiner to cite references in support of the Official Notice, and to also indicate where an explicit teaching to combine the cited reference may be found. Alternately, the Applicants request that the Examiner reconsider and withdraw the rejection of claim 41 under 35 U.S.C §103.

### Summary

Applicants submit that the foregoing amendments and remarks overcome the Examiner's rejections under 35 U.S.C. §102(e) and 35 U.S.C. §103(a). Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-42 so that the present Application may issue in a timely manner. If there are any questions concerning this amendment, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

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